

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONATHAN CRINION

Appeal No. 2001-0210
Application No. 08/560,675

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 22, 24-31 and 40. Claims 23 and 32-39 have been withdrawn as being directed to a non-elected invention, and the remaining claims have been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to a counterline comprising a series of adjacent modules. An understanding of the invention can be derived from a reading of exemplary claim 40, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wolff <u>et al.</u> (Wolff)	4,094,561	Jun. 13, 1978
Newhouse <u>et al.</u> (Newhouse)	5,237,935	Aug. 24, 1993
European Patent Application (Hoffman) ¹	0 010 301 A1	Apr. 30, 1980

Claims 40, 22 and 25-30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hoffman in view of Newhouse.

Claims 24 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hoffman in view of Newhouse and Wolff.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 13) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 12) and Reply Brief (Paper No. 14) for the appellant's arguments thereagainst.

OPINION

¹A PTO translation of this reference is enclosed. Although the name of the first listed inventor on this reference is Hildebrandt, the examiner has referred to it as Hoffman, and we shall do so also for the sake of continuity.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

All of the claims stand rejected under 35 U.S.C. § 103. Whether a claimed invention is unpatentable under 35 U.S.C. § 103 is a question of law based upon underlying findings of fact. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000). The underlying factual inquiries include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; and (3) the differences between the claimed invention and the prior art. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 460 (1966). What the prior art teaches and whether it teaches toward or away from the claimed invention also is a determination of fact. Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995). Similarly, whether one of ordinary skill in the art would have been motivated to combine prior art disclosures is also a question of fact. In re Gartside, 203 F.3d. at 1316, 53 USPQ2d at 1776. A suggestion, teaching, or motivation to combine prior art references may come from the references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1125, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000).

The appellant's invention is directed to a counterline comprising a series of individual modules with each module having opposed rectangular side frames structurally interconnected adjacent a front face thereof and a work surface supported by the side frames and sized to abut the work surfaces of adjacent modules to provide a continuous work surface therebetween. To facilitate the passage of wires and lines along the counterline, at least one longitudinal channel is provided in the front of each module, and movable means allow the channel to be opened to allow access and closed to hide the wires and lines from view. In accordance with these features, independent claim 40 recites that each module in the counterline comprises opposed side frames having front faces and "at least one upwardly opening channel member located adjacent a front face of said counterline and fixed to each side frame in an open notch thereof" (emphasis added), and "at least one of said work surfaces and said front cover panel of each module is movable between a closed position where access to said at least one channel is restricted to an open position allowing access."

The examiner is of the opinion that Hoffman discloses all of the subject matter recited in claim 40 except for connecting a plurality of modules together to form a counterline. However, it is the examiner's position that this feature is taught by Newhouse, and it would have been obvious to one of ordinary skill in the art to utilize a series of the Hoffman modules to form a counterline. We do not agree.

Hoffman discloses a desk having a system of ducts through which wires and the like can be run. The Hoffman desk comprises a pair of opposed side frames 2 and 3 (Figure 1) which appear to be interconnected by a pair of beams (unnumbered, but shown attached to side frame 3 in Figure 4 and side frame 2 in Figure 2), a tabletop 4, and a channel member 6. The channel member is mounted on a mechanism that allows it to be movable between a closed position beneath the tabletop (Figure 1), through a partially open position (Figure 2), to a fully open position spaced from the tabletop a distance sufficient to allow wires to be inserted or removed (Figure 4). As is best shown in Figure 4, the channel member is movably connected to the side frames through connecting means 16 and 28, with notches 37 being provided in the side frames to facilitate the interconnection of several desks, and notches 38 to permit wires to be inserted (translation, page 8). We do not agree with the rationale advanced by the examiner on pages 4 and 5 of the Answer regarding the correspondence between the terminology of claim 40 and the Hoffman structure.

There is a basic structural and operational difference between the Hoffman arrangement and that of claim 40. The channel member in the Hoffman invention is opened and closed by moving it with regard to the stationary work surfaces, side frames and notches. The arrangement recited in claim 40 requires the opposite, which is that the channel member be "fixed to each side frame in an open notch thereof" (emphasis added),

and it is opened and closed by moving the work surfaces and/or the front panels. Thus, Hoffman fails to disclose or teach this limitation of the claim.

Newhouse was cited by the examiner only for teaching constructing a counterline of a series of modules, a feature which, incidentally, already is present in Hoffman (translation, page 8). Be that as it may, it is our view that Newhouse fails to overcome the above-noted deficiency in the Hoffman reference. Thus, the combined teachings of Hoffman and Newhouse fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 40, and we will not sustain the rejection of claim 40 or, it follows, of dependent claims 22, 25 and 26.

Independent claim 27 stands rejected on the same basis. This claim requires, inter alia, “opposed side frames interconnected by at least one upwardly opening channel member located adjacent a front of said counterline” (emphasis added). The channel member is attached to side frames 2 and 3 by means of a sliding connection at the top of each side frame (elements 15 and 16) and a folding connection at the bottom (element 28), which allow it to be moved between closed (Figure 1) and open (Figure 2) positions. However, from our perspective, these sliding and folding links do not cause the channel member to “interconnect” the side frames to one another; that is accomplished by the unnumbered beams, as explained above. This being the case, we therefore also will not

sustain the rejection of independent claim 27 or dependent claims 28-30, on the basis of the same rationale advanced above with regard to claim 40.

Dependent claims 24 and 31 add to claims 40 and 27, respectively, the requirement that there be a plurality of channels. They stand rejected on the basis of Hoffman and Newhouse, taken further with Wolff, the latter being applied for teaching the use of a plurality of channels as “an alternative conventional structure used for the same intended purpose” to the single channel disclosed by Hoffman (Answer, page 5). Neither Newhouse nor Wolfe overcome the shortcoming in Hoffman discussed above, and therefore this rejection also is not sustained.

SUMMARY

Neither rejection is sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

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